

SEP 19 2006

REMARKS

This application was originally filed on 9 April 2001 with twenty-three claims, two of which were written in independent form. Claims 1, 2, 11, and 18 were amended, and Claims 20-23 canceled on 30 January 2006. Claims 19 and 20, but not the subject matter thereof, have been canceled without prejudice by this amendment in order to clarify the issues for appeal. No claims have been allowed.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,324,694 to Butler *et al.* ("Butler") in view of U.S. Patent No. 5,938,737 to Smallcomb ("Smallcomb"). The applicant respectfully disagrees.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham and Adams*." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The prima facie case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it." *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but

unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Graham v. Deere*, 383 U.S. 1, 17-18 (1966).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). ‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” MPEP § 2143.03.

“To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Claim 1 recites “receiving a terrestrial broadcast signal comprising a video stream,” “receiving said Internet-based content via satellite transmission,” and “transmitting information via landline transmission,” where “said embedded commands synchronized and correlated with additional Internet-based content.”

The Examiner stated, “Butler fails to specifically teach, said embedded commands synchronized and correlated with additional Internet-based content.” The Examiner further states, “Smallcomb discloses said embedded commands synchronized and correlated with additional Internet-based content . . . (satellite downstream telephone line upstream for internet data; col. 3, lines 41-67).”

The applicant respectfully submits the Examiner has not pointed to any teaching in Smallcomb that supports the Examiner’s assertion. Specifically, the Examiner has not pointed to any teaching in Smallcomb that the “embedded commands synchronized and correlated with additional Internet-based content” are “embedded in the video stream” as required by Claim 1, nor has the Examiner shown the references expressly or impliedly suggest the claimed combination or presented a convincing line of reasoning as to why the artisan would have found

the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Examiner has not met the burden of presenting a *prima facie* case of obviousness. Therefore, the rejection of Claim 1 under 35 U.S.C. § 103(a) as unpatentable over Butler in view of Smallcomb is defective and should be withdrawn.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Smallcomb.

The Examiner stated, "Ellis fails to specifically teach, said embedded commands synchronized and correlated with additional Internet-based content." The Examiner further states, "Smallcomb discloses said embedded commands synchronized and correlated with additional Internet-based content . . . (satellite downstream telephone line upstream for internet data; col. 3, lines 41-67)."

The applicant respectfully submits the Examiner has not pointed to any teaching in Smallcomb that supports the Examiner's assertion. Specifically, the Examiner has not pointed to any teaching in Smallcomb that the "embedded commands synchronized and correlated with additional Internet-based content" are "embedded in the video stream" as required by Claim 1, nor has the Examiner shown the references expressly or impliedly suggest the claimed combination or presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Examiner has not met the burden of presenting a *prima facie* case of obviousness. Therefore, the rejection of Claim 1 under 35 U.S.C. § 103(a) as unpatentable over Ellis in view of Smallcomb is defective and should be withdrawn.

Claim 11 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0117831 to Ellis *et al.* The applicant respectfully disagrees and submits the Examiner has failed to make a *prima facie* case of anticipation.

Claim 11 recites, "providing a broadcast signal comprising a video stream."

The Examiner stated, "As to claim 11 Ellis *et al.* discloses: providing a broadcast signal comprising a video stream ('FIG. 1 shows a video broadcasting system in accordance with one embodiment of the invention, generally designated by reference numeral 10. Broadcasting system 10 includes a broadcast source 12 and a plurality of receivers 14. The broadcast source in this

embodiment of the invention is a digital satellite system that broadcasts video content on multiple RF frequencies or channels.’ [0013]).”

The applicant respectfully submits this passage, which appears to be from Butler, is not found in Ellis. Therefore the Examiner has not cited any teaching in Ellis that would anticipate this limitation of Claim 1.

Claim 11 recites, “embedding commands in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content.”

The Examiner stated, “As to claim 11 Ellis et al. discloses: . . . embedding commands in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content (‘Broadcast source 12 includes means for transmitting or otherwise conveying a primary video stream and ancillary digital data content to receivers 14. In the case of digital satellite transmission, ancillary data can be easily transmitted in digital form along with video and audio streams. Protocols such as MPEG-2 already provide for incorporating ancillary digital data in packets that are downloaded with digital audio/video content using satellite transmission facilities. Another example is in the analog realm, in which Philips sells a device called the Ghost Echo Cancellation Reference Signal. By injecting a known digital stream on a single analog television VBI line, advanced televisions or PCs can more easily detect when a multipath (ghost) signal is received and take measures to clean up the image’ [0015]; ‘A step 222 comprises formatting supplemental data files in a graphical markup language, preferably HTML. Each supplemental HTML data file has instructions for rendering a hyperlink page or overlay on the video stream at an indicated time. Overlays can also contain hyperlinks to other overlays and to other non-overlay documents and objects’ [0051]).”

The applicant respectfully submits this passage, which appears to be a misquote of Butler, is not found in Ellis. Therefore the Examiner has not cited any teaching in Ellis that would anticipate this limitation of Claim 1.

Claim 11 recites, “displaying said additional Internet-based content superimposed on said video stream from said broadcast signal.”

The Examiner stated, "As to claim 11 Ellis et al. discloses: . . . 'displaying said additional Internet-based content superimposed on said video stream from said traditional broadcast signal ('FIG. 3 shows how this is accomplished. An overlay window 200 is opened for displaying a hyperlink overlay. Video subsystem 66 is configured to display the video stream in a viewport 201 that coincides in size and position with the overlay window 200. Thus, non-transparent areas of the hyperlink overlay appear 'through' the video stream, and appear to overlay the video stream' [0044]; 'A step 222 comprises formatting supplemental data files in a graphical markup language, preferably HTML. Each supplemental HTML data file has instructions for rendering a hyperlink page or overlay on the video stream at an indicated time. Overlays can also contain hyperlinks to other overlays and to other non-overlay documents and objects' [0051])."

The applicant respectfully submits this passage, which appears to be a misquote of Butler, is not found in Ellis. Therefore the Examiner has not cited any teaching in Ellis that would anticipate this limitation of Claim 1.

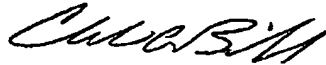
As the Examiner failed to present a *prima facie* case of anticipation of Claim 11 by Ellis, the rejection of Claim 11 is unsupported by the prior art and should be withdrawn.

Claims 2, 4, 12, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Butler in view of Smallcomb. Claims 3, 5-10, 12-13, and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Smallcomb.

Claims 2-10, and 12-17 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. For the reasons stated above with respect to Claim 1, Butler, Smallcomb, and Ellis do not appear to show, teach, or suggest the limitations of the independent claims, much less the limitations of the independent claims in combination with the additional limitations of the dependent claims.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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